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| 09/457,842 | 12/09/1999 | SATORU SAWADA | 12924(JA998- | 8134 |

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| EXAMINER | |
|---|---|
| SHERR, CRISTINA O | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3621 | |

DATE MAILED: 11/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/457,842 | SAWADA ET AL. | |
| | Examiner | Art Unit | |
| | Cristina O Sherr | 3621 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☐ Responsive to communication(s) filed on _____.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-8,10-16 and 20-23* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8,10-16 and 20-23* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

13)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

a) ☐ The translation of the foreign language provisional application has been received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

1. This communication is in response to applicant's amendment filed 29 August 2003 and received 2 September 2003. Claims 1-8, 10-16 and 20-23 are currently pending. Claims 1,2,3,10 and 13 have been amended.

***Response to Arguments***

2. Applicant's arguments filed 29 August 2003 have been fully considered but they are not persuasive.

3. With respect to accounting logic used for dynamically charging, for the use of defined object data, and recognized data, applicant is respectfully directed to Downs et al (US 6,226,618B1) Col. 3, ln 40-56.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 20, and 21 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

6. Regarding claim 1 –

Downs discloses a data charging system comprising a content generator for generating contents containing object data, a recording medium for recording the charging data used for charging f or said object data and the recognition data used for recognition of

the object data, and a data charging apparatus for charging for the use of said object data by using said charging data and said recognition data recorded; wherein said data charging apparatus comprises data reading logic for reading said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, an recognition logic for recognizing said separated object data by using said recognition data read out, an accounting logic for charging for the use of said recognized object data by using said charging data read out, and a writing logic for writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (Col. 3, ln 40-56).

7. Regarding claim 20 –

Downs discloses a data charging system according to claim 1, wherein the content generator generated a digital watermark embedded in said contents (Col. 4, ln 1-22).

8. Regarding claim 21 –

Downs discloses a data charging system according to claim 20, wherein the content generator generates watermark information about the digital watermark and also embedded in said contents (Col. 4, ln 15-40).

9. Claim 2 is rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

Downs discloses a content generator for embedding digital watermarks in object data and generating contents in a data charging system which records, on a recording medium, the charging data used for charging for object data contained in said contents and the recognition data used for recognizing the object data and charges only for the

use of the object data embedded with said digital watermarks by using said charging data and said recognition data recorded (Col. 3, ln 40-42).

10. Claims 3-8 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

11. Regarding claim 3 –

Downs discloses a data charging system which records, on a recording medium, the charging data used for charging for object data contained in said contents and the recognition data used for recognizing the object data and charges for the use of said object data by using said charging data and said recognition data recorded, a data charging apparatus comprising: a data reading logic for reading said recognition data and said charging data from said recording medium, a separator for separating said object data from said contents, an recognition logic for recognizing said separated object data by using said recognition data read out, an accounting logic for charging for the use of said recognized object data by using said charging data read out, and a writing logic for writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (Col. 3, ln 40-56).

12. Regarding claim 4 –

Downs discloses the data charging apparatus according to Claim 3, wherein said contents comprise said object data and said recognition data for recognizing this object data, said separator separates said object data and said recognition data from said contents, said recognition logic recognizes said object data, based on said recognition data separated from said contents and on said recognition data read out from said

recording medium, and said accounting logic charges for said object data by using said charging data read out (Col. 3, ln 40-45).

13. Regarding claim 5 –

Downs discloses the data charging apparatus according to Claim 3, further comprising a watermarking logic for embedding digital watermarks in said object data separated from said contents, wherein said separator separates said object data and said recognition data from said recognition logic recognizes said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charges for said object data embedded with said digital watermarks (Col. 3, ln 42-50).

14. Regarding claim 6 –

Downs discloses the data charging apparatus according to Claim 3, wherein a digital watermark is embedded in said object data in said contents, said data charging apparatus further comprising a means for detecting if said object data is embedded with said digital watermark, said separator separating said object data and said recognition data from said contents, said recognition logic recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium, and said accounting logic charging for said object data only if said object data is found to be embedded with said digital watermark (Col. 3, ln 50-56).

15. Regarding claim 7 –

Downs discloses the data charging apparatus according to Claim 3, wherein said charging data recorded on said recording medium contains at least payment data which indicates the payment made in advance for the use of said object data, and said accounting logic charges for the use of said object data within the limits of the amount indicated by said payment data contained in said charging data (Col. 4, In 2-10).

16. Regarding claim 8 –

Downs discloses the data charging apparatus according to Claim 7, wherein said charging data recorded on said recording medium further contains unit price data representing the accounting unit for the use of said object data and the price corresponding to the accounting unit, said data charging apparatus comprising an accounting unit detection logic for detecting unit accounting amount data which represents the amount of said accounting unit for the object data separated from said contents, said accounting logic charging within the limits of the amount indicated by said payment data, based on said unit price data contained in said charging data read out and on the unit accounting amount data detected (Col. 4 In 2-10).

17. Claims 10-12 and 22-23 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

18. Regarding claim 10 –

Downs discloses a data charging method for generating contents which contain object data and recognition data used for the recognition of this object data, recording the charging data used for charging for said object data and the recognition data used for recognition of the object data, and charging for the use of said object data by using said

charging data and said recognition data recorded, comprising the steps of reading said recognition data and said charging data from said recording medium, separating said object data from said contents, recognizing said separated object data by using said recognition data read out, charging for the use of said recognized object data by using said charging data read out; and writing, as said charging data, the results of charging for the use of said recognized object data into said recording medium (Col. 3, ln 40-56).

19. Regarding claim 11 –

Downs discloses a data charging method according to Claim 10, wherein said object data in said contents are embedded with digital watermarks, comprising the steps of separating said object data and said recognition data from said contents; recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium; detecting said digital watermark embedded in said object data; and charging for said recognized object data only by using said charging data read out if said object data is found to be embedded with said digital watermark (Col. 3, ln 42-45).

20. Regarding claim 12 –

Downs discloses a data charging method according to Claim 10, comprising the steps of separating said object data and said recognition data from said contents recognizing said object data, based on said recognition data separated from said contents and on said recognition data read out from said recording medium; embedding digital watermarks in said separated object data; and charging for the use of the object data

embedded with said digital watermarks by using said charging data read out (Col. 3, In 45-50).

21. Regarding claim 22 –

Downs discloses a method according to claim 11 further comprising the step of embedding in said contents information about the digital watermark (Col. 3, In 50-56).

22. Regarding claim 23 –

Downs discloses a method according to claim 22 wherein the embedding step includes the step of embedding in said contents instructions foe embedding the contents with said digital watermarks (Col. 3, In 45-50).

23. Claims 13-16 are rejected under 35 U.S.C. 102(e) as being anticipated by Downs et al (US 6,226,618B1).

24. Regarding claim 13 –

Downs discloses a data charging apparatus of a data charging system which records, on a recording medium, the charging data used for charging for the object data contained in contents and the recognition data used for recognition of the object data, and charges for the use of said object data by using said charging data and said recognition data recorded; a computer program product enabling a computer to execute the steps of reading said recognition data and said charging data from the recording medium, separating said object data from said contents, recognizing said separated object data by using said recognition data read out, charging for the use of said recognized object data by using said charging data read out, and writing, as said

charging data, the results of charging for the use of said recognized object data into said recording medium (Col. 3, ln 40-56).

25. Regarding claim 14 –

Downs discloses the computer program product according to Claim 13, wherein said contents contain said object data and said recognition data used for recognition of the object data, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data in said charging step by using said charging data read out (Col. 3, ln 42-50).

26. Regarding claim 15 –

Downs discloses the computer program product according to Claim 13, wherein the computer is made to execute the step of embedding digital watermarks in said object data separated from said contents, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data embedded with said digital watermarks in said charging step (Col. 3, ln 50-56).

27. Regarding claim 16 –

Downs discloses the computer program product according to Claim 13, wherein said object data in said contents are embedded with digital watermarks, the computer is

further made to execute the step of detecting that said object data is embedded with said digital watermarks, said object data and said recognition data are separated from said contents in said separation step, said object data is recognized in said recognition step, based on said recognition data separated from said contents and on said recognition data read out from the recording medium, and a charge is made for said object data in said charging step only if said object data is found to be embedded with said digital watermark (Col. 4, ln 2-10).

28. Examiner's note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may be applied as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention as well as the context of the passage as taught by the prior art or disclosed by the examiner.

***Conclusion***

**29. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

30. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

31. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cristina O Sherr whose telephone number is 703-305-0625. The examiner can normally be reached on Monday through Friday 8:30 to 5:00.

32. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687.

33. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

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